

B1 cont'd
in which R¹³ is acetyloxy or hydroxy; R¹⁴ is hydrogen.

REMARKS

Entry of the present amendment and institution of an interference between the present application and U.S. Patent No. 5,254,580 to Chen et al. is respectfully requested.

The Chen et al. Patent

On October 19, 1993, the U.S. Patent and Trademark Office issued U.S. Patent No. 5,254,580 to Chen et al. This patent issued from patent application Serial No. 29,819 filed March 11, 1993, which was a continuation-in-part of Serial No. 6,423 filed January 19, 1993 which was, in turn, a continuation of Serial No. 907,261, filed July 1, 1992.

Compliance with 35 U.S.C. §135(b)

Applicants, in accordance with the requirements of 35 U.S.C. §135(b), have specifically presented claims herein which are for substantially the same subject matter as claims 1, 8, 9 and 10 of the Chen et al. patent. The Chen et al. patent issued on October 19, 1993, and, hence, these claims are being presented within one year from the date on which the Chen et al. patent was granted.

Compliance with Requirements of 37 C.F.R. §1.607

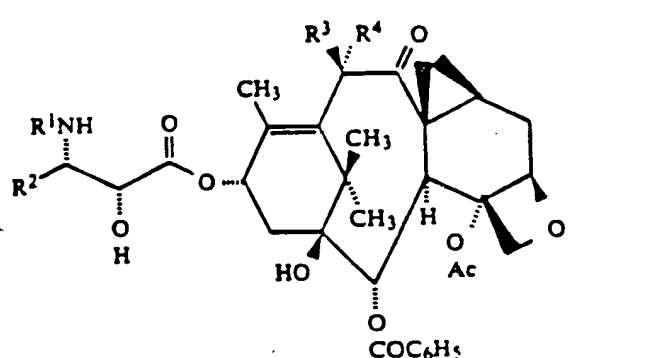
1. Identification of the Patent

As noted hereinabove, applicants have substantially copied claims 1, 8, 9 and 10 of the Chen et al. patent, U.S. Patent No. 5,254,580.

2. Proposed Counts of the Interference

Count 1.

1. A compound of formula I



in which

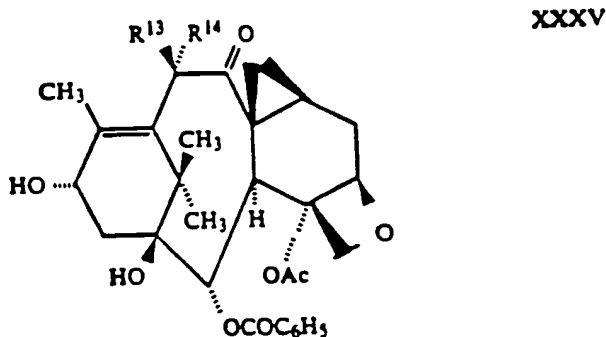
R^1 is $-COR^2$ in which R^2 is t-butyloxy, C_{1-6} alkyl, C_{2-6} alkenyl, C_{2-6} alkynyl, C_{3-6} cycloalkyl, or phenyl, optionally substituted with one to three same or different C_{1-6} alkyl, C_{1-6} alkoxy, halogen or $-CF_3$ groups;

R^2 is C_{1-6} alkyl, C_{2-6} alkenyl, C_{2-6} alkynyl, C_{3-6} cycloalkyl, or a radical of the formula $-W-R^x$ in which W is a bond, C_{2-6} alkenediyl, or $-(CH_2)_t-$, in which t is one to six; and R^x is naphthyl, furyl, thienyl or phenyl, and furthermore R^x can be optionally substituted with one to three same or different C_{1-6} alkyl, C_{1-6} alkoxy, halogen or $-CF_3$ groups;

R^3 is $OCOR$, $-OCOOR$, H , or OH ; R^4 is hydrogen; or R^3 and R^4 jointly form a carbonyl group; and R is C_{1-6} alkyl.

Count 2.

A compound of formula XXXV



in which R¹³ is hydrogen, acetyloxy or hydroxy; R¹⁴ is hydrogen; or R¹³ and R¹⁴ jointly form a carbonyl group.

This proposed presentation of counts is not exclusive.

3. Identification of Patent Claims Corresponding to Proposed Counts

Claims 1 to 9 of the Chen et al. patent correspond to proposed count 1. Proposed count 1 is claim 1 of the Chen et al. patent and dependent compound claims 2 to 7 would correspond to count 1. Chen et al. pharmaceutical formulation claim 8 and method of treatment claim 9 both depend from compound claims 1 to 7 and, hence, also correspond to proposed count 1.

Claim 10 of the Chen et al. patent corresponds to proposed count 2.

4. Presentation of Claims and Identifying Pending Claims Corresponding to Proposed Claims

Claims 98, 99 and 100 correspond to proposed count 1. Instant claim 98 recites substantially the same subject matter as proposed count 1. Several minor limitations for which applicants do not believe they have adequate basis have been deleted. Claim

101, presented herewith, recites substantially the same subject matter as proposed count 2 and corresponds thereto.

Claims 1, 2, 3, 4, 31, 32, 43, 44, 45, 46, 47, 50, 51, 52, 53, 79, 80, 91, 92, 93, 94, 95, 96 and 97 which are presently pending in the instant application correspond to proposed count 1.

Originally presented claim 30 corresponds to proposed count 2.

5. Support in The Original Disclosure
For Newly Presented Claims 98 to 101

Claim recitation

Specification Support

98. A compound of formula I

page 1, line 4 shows a compound with a formula which is substantially the same as recited in new claim 98.

R¹ is ...

page 1, line 1 to page 2, line 23 defines a substituent R₁ including the possibilities of benzoyl and R₂-O-CO-O in which R₂ is optionally substituted, alkyl, alkenyl, alkynyl and cycloalkyl.

R² is -W-R^x...

The formula on page 1 contains an Ar substituent which is directly bonded to the side chain and page 2, line 24 to page 4, line 24, discloses possible Ar groups such as optionally substituted phenyl, optionally substituted naphthyl, optionally substituted 2- or 3-thienyl or 2- or 3-furyl radicals.

R³ is -OCOR, or
OH, R⁴ is hydrogen

The formula on page 1 shows
only an OR substituent. The H
substituent at this position is
understood. R in the formula is defined
on page 1, lines 9 and 10 to be
hydrogen, acetyl or alkyl.

99. A pharmaceutical form-
page 44, lines 20-24
ulation

active ingredient as see support for claim 98,
claim in claim 98 above

associated with... page 44, lines 25-28.

100. A method for treatingpage 43, lines 15 to
mammalian tumors... page 44, line 11

administering to a mammal...page 44, lines 12-19

compound as claimed in claimsee support for claim 98,
98 above.

101. A compound of formula
page 10, line 7 shows the
XXXV formula corresponding to formula XXXV
 wherein G₁ is defined on page 5, 18-20
 as hydrogen or acetyl.

Applicants are Prima Facie Entitled to Judgment of Priority

All of the claims of the Chen et al. patent including
claims 1, 8, 9 and 10 copied herein recite 7,8 cyclopropyl taxane
derivatives. These claims and the disclosure supporting these
claims were presented by Chen et al. in application Serial No.

1160

29,819, filed March 11, 1993. The March 11, 1993 application was specifically designated as a continuation-in-part of application Serial No. 6,423 filed January 19, 1993. Serial No. 6,423 was a continuation of Serial No. 907,261 which was filed July 1, 1992 and the disclosures of these applications are identical. Neither of the first two filed applications provided any support for or description of the preparation of cyclopropyl taxane derivatives. These applications were directed to 7-halo-taxane derivatives which were obtained by use of DAST, a known fluorinating agent. Neither application either specifically indicated or in any way suggested that cyclopropyl taxane derivatives were formed.

The present application was filed in the United States on December 8, 1993 and priority was claimed to a French patent application filed December 9, 1992. Applicants have filed a certified translation of the French priority document perfecting their right to the December 9, 1992 effective filing date for the U.S. patent application. Both the French patent application and the present U.S. patent application teach and disclose the preparation of cyclopropyl taxane derivatives using a reaction sequence intended to form the cyclopropane derivatives.

In effect, applicants' disclosure of cyclopropyl taxane derivatives is well before the initial March 11, 1993 disclosure of such compounds in the Chen et al. applications. Applicants enabled the preparation and use of cyclopropyl taxane compounds as of their December 9, 1992 effective filing date while the earliest date at which Chen et al. described and enabled the preparation and use of such compounds is urged to be March 11, 1993. For the convenience of the Examiner, enclosed herewith is a copy of the Chen et al. original patent application disclosure.

Applicants respectfully submit that the above statement complies with the requirements of 37 C.F.R. §1.608(b) and provides a prima facie showing that applicants are entitled to a judgment of priority of invention.

Conclusion

Applicants believe that they have complied with the requirements of 37 C.F.R. §1.607 and 37 C.F.R. §1.608(b). The entry of the claims copied from the Chen et al. patent and the institution of an interference proceeding is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for this amendment, or credit any overpayment to Deposit Account No. 13-4500, Order No. 1290-7281. DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,

Date

10/18/94

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